

REMARKS

Prior to further examination on the merits, applicants request entry and reconsideration based on the instant preliminary amendment and reply.

As an initial matter, the applicants have confirmed the number of claims filed with the records maintained by the assignee and agree with the examiner's observation that the application was originally filed with 21 claims. Accordingly, the examiner's renumbering of the claims is proper.

In the Office Action dated March 12, 2003 (and in the Advisory Action dated May 22, 2003), claims 1, 3-5, 9-12, 14, 15, 18, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,901,224 to Hecht (hereafter "Hecht"), further in view of U.S. patent 6,400,392 to Yamaguchi et al. (hereafter "Yamaguchi"). Claims 6-8, 16, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hecht, further in view of U.S. patent 5,444,779 to Daniele (hereafter "Daniele"). Claims 13 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hecht. Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hecht, further in view of U.S. patent 6,253,184 to Ruppert (hereafter "Ruppert"). Applicants respectfully traverse these rejections, insofar as they may be applied to the amended claims, for at least the following reasons.

Independent Claims 1, 20, and 22

With respect to independent claims 1, 20, and 22 each of these claims recite an electronic document encoding *and* processing method (or system) in which the following sequence of steps is performed: (1) electronic document is created and stored, (2) a mark is placed on a hardcopy corresponding to the stored electronic document including both identification and processing information for the electronic document, (3) an image of a hardcopy of captured by an image capture device; (4) the mark is decoded; (5) the electronic document corresponding to the hardcopy is retrieved based on the decoded identification information from the mark, and the (6) retrieved electronic document is processed in accordance with the processing information from the mark.

The Office Action relies on Hecht for disclosing this claimed sequence. However, Hecht does not disclose or suggest this recited sequence of steps. Specifically, Hecht relates

to a process of “quasi-reprographically” replicating a source document. That is, as shown in Fig. 1 of Hecht, a source document is input into a document storage 30, a glyph detector 32 detects a mark (or glyph) and a glyph decoder 34 decodes the detected mark. However, nowhere does Hecht teach or suggest retrieving a previously stored electronic document corresponding to a hardcopy based on decoding a mark on the hardcopy which identifies the previously stored electronic copy.

That is, Hecht does not disclose or suggest the following claimed features identified above (in the correct claimed sequence): (1) electronic document is created and stored apriori to the image capture and decoding process, (2) a mark is placed on a hardcopy corresponding to the stored electronic document including both identification and processing information for the electronic document (since Hecht does not disclose a previously stored electronic document separate from the image capture and decoding process), (5) the electronic document corresponding to the hardcopy is retrieved based on the decoded identification information from the mark, and (6) retrieved electronic document is processed in accordance with the processing information from the mark.

These deficiencies of Hecht are not cured by any of the other applied references. Accordingly, the pending claims are believed to be patentable over the applied prior art.

Specifically, as discussed earlier, Yamaguchi is directed to a *video information* adjusting apparatus (together with receiving and transmitting video information) such as that used in videotelephones or video conferencing systems. *See, e.g., col. 1, lines 7-18 of Yamaguchi.* Therefore, Yamaguchi does not disclose or suggest the claimed sequence discussed above in each of the independent claims.

Ruppert was cited for disclosing a voice activated copier apparatus and does not disclose or suggest the features discussed above with respect to each of the independent claims. Accordingly, the pending independent claims are believed to be patentable over the applied prior art.

Dependent Claims

The dependent claims are also allowable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

Comments in the Advisory Action

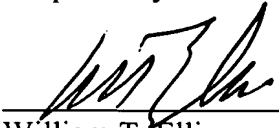
Applicants note that with respect to the document waving activation of the image capture, the Office Action notes that it would have been obvious based on the hand gesture activation of a video conferencing system of Yamaguchi while implicitly acknowledging that this recited feature is not disclosed in the cited prior art. In fact, in a video-conferencing system, documents are generally presented in a separate window from an electronic source and activation based on waving a document would not have been obvious (or even desirable) at all. In this regard, applicants note that hindsight reconstruction based on the applicants' own disclosure is impermissible under Supreme Court precedent.

With respect to the citation to col. 8, lines 1-15 of Hecht, applicants note that the "identification" information therein relates to identifying authenticity of the document like a "digital watermark" and does not relate in any way to the claimed identification information for retrieval of a previously stored electronic document as recited in the pending claims

In view of the foregoing amendments and remarks, applicants believe that the application is now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local number below.

Respectfully submitted,

6/12/03
Date



William T. Ellis
Registration No. 26,874

ATTACHMENT A

**Marked up version of claim amendments made in the Preliminary Amendment
filed June 12, 2003**

1. (Twice Amended) A method of processing an electronic document corresponding to a hardcopy of the document, comprising the steps of:

creating and storing the electronic document;

placing a mark on the hardcopy corresponding to the stored electronic document, the mark containing identification information and processing information of the electronic document;

viewing the hardcopy by an image capture device to capture an image of the hardcopy document, wherein the image capture device is activated by waving a copy of the hardcopy document in front of the image capture device;

decoding the mark from the image captured by the image capture device to determine the identification information of the electronic document and the processing information of the electronic document;

retrieving the electronic document based on the determined identification information of the electronic document; and

processing the retrieved electronic document according to the [identification] processing information.

20. (Twice Amended) A system for processing an electronic document corresponding to a hardcopy of the electronic document, the system comprising:

a data storage device that stores the electronic document;

a mark encoder that encodes a mark on the hardcopy corresponding to the stored electronic document, the mark indicative of identification information and processing information for the electronic document;

an image capture device that captures an image of the hardcopy including the mark, wherein the image capture device is configured to be activated by waving the hardcopy in front of the image capture device;

a decoder, operatively connected to the image capture device, for decoding [document] the identification information and the processing information from the mark from the image captured by the image capture device; and

a processing unit, connected to the decoder and the data storage device, that retrieves the electronic document based on the identification information and processes the electronic document in accordance with the decoded [document identification] processing information.

22. (Amended) A method of processing an electronic document corresponding to a hardcopy of the document, comprising the steps of:

creating and storing the electronic document;

receiving a voice input indicative of an annotation or processing instruction for the document;

placing a mark on the hardcopy, the mark containing identification information of the electronic document and the annotation or processing instruction for the document received from the voice input;

viewing the hardcopy by an image capture device to capture an image of the hardcopy document;

decoding the mark from the image captured by the image capture device to determine the identification information and the processing instruction for [of] the electronic document;

retrieving the electronic document based on the determined identification information;

and

processing the retrieved electronic document according to [the identification information and] the annotation or processing instruction.